

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Edward A. Marue and  
Kenneth J. Pereira

Serial No: 09/596,850

Filed: June 19, 2000

Title: TELESCOPING MAST WITH  
INTEGRAL PAYLOAD

Examiner: R. Ramirez

Art Unit: 3632

Date: February 6, 2002

**RECEIVED**  
FEB 19 2002  
OFFICE OF PETITIONS  
DEPUTY A/C PATENTS

**PETITION FOR FILING OF REISSUE CONTINUATION APPLICATION  
WITHOUT DECLARATION OF JOINT INVENTOR UNDER 37 C.F.R. §1.83**

Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Sir:

**BACKGROUND/STATEMENT OF FACTS**

On March 31, 1999, Applicant filed a reissue application, Serial No. 09/283,843, stemming from U.S. Patent No. 5,615,855 issued on April 1, 1997 and naming Edward Marue and Kenneth Pereira as the inventors. The reissue application was filed with reissue oath/declarations executed by both inventors in accordance with 37 C.F.R. §1.175 and M.P.E.P. §1404. These declarations were supplemented with additional declarations executed by the inventors Marue and Pereira in accordance with M.P.E.P. §1414.01. Copies of each of these declarations are attached herewith behind Tab 1.

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On June 19, 2000, Applicant filed a continuation reissue application Serial No. 09/596,850 claiming priority to reissue application Serial No. 09/283,843 in accordance with M.P.E.P. §1451. The instant continuation application was not originally filed with the reissue declarations required of 37 C.F.R. §1.175 and M.P.E.P. §1414 as it was the undersigned Applicant's representative's incorrect understanding that a continuation of a reissue application did not require such declarations.

Initially, the Examiner in charge of the present application also did not understand that the present application required declarations of the inventors in accordance with M.P.E.P. § 1414 and the Examiner issued a Notice of Allowance on October 6, 2000. Thereafter, the issue fee in connection with the present application was paid on October 24, 2000. However, the instant application did not result in an issued patent as on February 13, 2001 the Examiner issued an Office Action indicating that the present continuation reissue application required the declarations of the inventors under 37 C.F.R. §1.175. Applicant responded by providing a declaration of one of the inventors, namely that of Edward Marue. A copy of this declaration is attached herewith behind Tab 2. However, inventor Kenneth Pereira refused at this time to sign an additional declaration. The undersigned made numerous attempts to contact Mr. Pereira by mail and by telephone. All attempts were unsuccessful. However, the undersigned attorney was able to reach Mr. Pereira's girlfriend "Linda". "Linda" indicated that Mr. Pereira would not be willing to sign any documents supporting the instant application.

Mr. Pereira's last known address is: 1581 18<sup>th</sup> Avenue, Kingsburg, California 93631.

In light of Applicant's inability to obtain a declaration from one of the joint inventors, Applicant filed a Petition for Filing of Reissue Application Without Declaration of Joint Inventor on August 13, 2001 under 37 C.F.R. §1.47. A copy of this Petition is attached herewith behind Tab 3.

Applicant has now received a response from the Examiner indicating that the Petition under Rule 1.47 was improper, and that the Petition needed to be filed under Rule 1.183. A copy of the Examiner's response is attached herewith behind Tab 4.

In accordance with the Examiner's suggestion, Applicant respectfully requests that the requirement of a declaration by one of the joint inventors under 37 C.F.R. §1.175 be waived. This waiver is believed to be particularly reasonable as the joint inventor Pereira initially executed such a declaration in connection with the instant continuation reissue application's parent application, Serial No. 09/283,843.

The fee set forth in 37 C.F.R. §1.17(h) is also submitted herewith.

I hereby declare that all statements made herein are of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so

made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed on this 6<sup>th</sup> day of February, 2002, at Newport Beach, California.

A handwritten signature in cursive script, appearing to read "David G. Duckworth", written in black ink.

David G. Duckworth

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors:	Edward A. Marue Kenneth J. Pereira
Assignee:	Tri-Ex Tower Corporation
Serial No:	353,118
Filed:	December 9, 1994
Patent No:	5,615,855
Issue Date:	April 1, 1997
Title:	TELESCOPING MAST WITH INTEGRAL PAYLOAD

**REISSUE APPLICATION DECLARATION BY  
CO-INVENTOR EDWARD A. MARUE**

Box: 7  
Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

As an above- named co-inventor, I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is described and claimed in Patent No. 5,615,855, granted April 1, 1997, and for which a reissue patent is sought on the invention entitled "Telescoping Mast Assembly With Integral Payload", the specification of which was filed on March 31, 1999 and was amended on March 31, 1999.

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by the amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, by reason of the patentees claiming more or less than they had the right to claim in the patent.

At least one error upon which reissue is based is described as follows. The co-inventors and their assignee may have claimed more than they had a right to claim in light of prior art that was not cited during prosecution of the application that resulted in issuance of the '855 patent. This prior art has now been provided to the United States Patent and Trademark Office in support of this reissue application, in the form of an Information Disclosure Statement. This prior art was not known to the inventors of the subject matter disclosed in the '855 patent or their attorneys until after issuance of the '855 patent.

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicants, the above-named co-inventors and their assignee. As a named inventor, I hereby appoint William H. Drummond, Registration No. 20,590, David G. Duckworth, Registration No. 39,516, DRUMMOND & DUCKWORTH, to prosecute this reissue application and transact all business in the United States Patent and Trademark Office connected therewith.

Please direct all future communications concerning the reissue application to:

William H. Drummond  
David G. Duckworth  
DRUMMOND & DUCKWORTH  
4590 MacArthur Blvd., Suite 500  
Newport Beach, California 92660  
Telephone: (949) 724-1255  
Facsimile: (949) 724-1139

I hereby declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful statements may jeopardize the validity of this reissue application, and any patent issuing thereon, or any patent to which this declaration is directed.

I am a citizen of the United States of America. My residence and Post Office address is 7570 Calle Sin Controversia, Tucson, Arizona 85718.

Date: 4-12-99

Edward A. Marue  
Edward A. Marue





THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors:	Edward A. Marue Kenneth J. Pereira
Assignee:	Tri-Ex Tower Corporation
Serial No:	353,118
Filed:	December 9, 1994
Patent No:	5,615,855
Issue Date:	April 1, 1997
Title:	TELESCOPING MAST WITH INTEGRAL PAYLOAD

**REISSUE APPLICATION DECLARATION BY  
CO-INVENTOR KENNETH J. PEREIRA**

Box: 7  
Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

As an above named co-inventor, I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is described and claimed in Patent No. 5,615,855, granted April 1, 1997, and for which a reissue patent is sought on the invention entitled "Telescoping Mast Assembly With Integral Payload", the specification of which was filed on March 31, 1999 and was amended on March 31, 1999.

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by the amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, by reason of the patentees claiming more or less than they had the right to claim in the patent.

At least one error upon which reissue is based is described as follows. The co-inventors and their assignee may have claimed more than they had a right to claim in light of prior art that was not cited during prosecution of the application that resulted in issuance of the '855 patent. This prior art has now been provided to the United States Patent and Trademark Office in support of this reissue application in the form of an Information Disclosure Statement. This prior art was not known to the inventors of the subject matter disclosed in the '855 patent or their attorneys until after issuance of the '855 patent.

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicants, the above-named co-inventors and their assignee. As a named co-inventor, I hereby appoint William H. Drummond, Registration No. 20,590, David G. Duckworth, Registration No. 39,516, DRUMMOND & DUCKWORTH, to prosecute this application and transact all business in the United States Patent and Trademark Office connected therewith.

Please direct all future communications concerning the reissue application to:

William H. Drummond  
David G. Duckworth  
DRUMMOND & DUCKWORTH  
4590 MacArthur Blvd., Suite 500  
Newport Beach, California 92660  
Telephone: (949) 724-1255  
Facsimile: (949) 724-1139

I hereby declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful statements may jeopardize the validity of this reissue application, and any patent issuing thereon, or any patent to which this declaration is directed.

I am a citizen of the United States of America. My residence and Post Office address is 8178 East Grangeville, Hanford, California 93230.

Date: April 12, 1999

Kenneth J. Pereira  
Kenneth J. Pereira

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Edward A. Marue  
Kenneth J. Pereira

Docket No: 546-P-8-USA

Assignee: The Will-Burt Co.

Reissue App. No: 09/596,850

Re. Filing Date: June 19, 2000

Title: TELESCOPING MAST WITH  
INTEGRAL PAYLOAD

**DECLARATION OF EDWARD A. MARUE**

Box: 7  
Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

As inventor of the above-identified application, I hereby declare that:

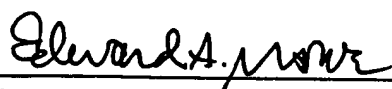
Applicant believes the original patent to be partly inoperative or invalid by reason of the Patentee claiming more or less than Patentee had the right to claim in the patent. Applicant erroneously claimed more than they had a right to claim in light of prior art that was not cited during prosecution of the application that resulted in issuance of the 5,615,855 patent. More particularly, Claim 1 of the '855 patent claims a telescoping mast assembly including a plurality of nesting telescoping mast sections wherein a payload is located only

in the top section of the mast sections. Meanwhile, U.S. Patent No. 3,347,003 issued to *Lapp* discloses such a structure. Accordingly, Claim 1 of the '855 patent is believed invalid under 35 U.S.C. § 102. This prior art was previously provided to the United States Patent and Trademark Office in support of this reissue application in the form of a previously filed Information Disclosure Statement.

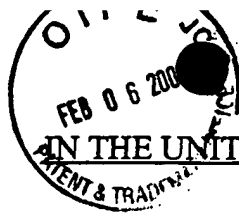
Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the Applicant.

I hereby declare that all statements made herein are of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this reissue application and any patent issued thereon, or any patent to which this declaration is directed.

Executed on this 16 day of MARCH, 2001, at Tucson, Arizona.

  
\_\_\_\_\_  
Edward A. Marue

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Edward A. Marue and  
Kenneth J. Pereira

Serial No: 09/596,850

Filed: June 19, 2000

Title: TELESCOPING MAST WITH  
INTEGRAL PAYLOAD

Examiner: R. Ramirez

Art Unit: 3632

Date: August 13, 2001

**PETITION FOR FILING OF REISSUE CONTINUATION APPLICATION  
WITHOUT DECLARATION OF JOINT INVENTOR**

Hon. Commissioner of Patents  
and Trademarks  
Box: No Fee Amendment  
Washington, DC 20231

Sir:

The above-identified continuation reissue application was filed on June 19, 2000. The Examiner has requested that declarations be submitted by the inventors including an explanation of the error in the parent patent, U.S. Patent No. 5,615,855 filed on December 9, 1994.

The parent '855 patent was filed naming inventors Edward Marue and Kenneth Pereira. A declaration of Edward Marue is submitted herewith. However, Kenneth Pereira refuses to join in filing the present application which has been assigned to The Will-Burt Company, along with the '855 patent.



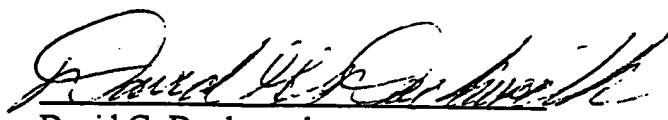
The undersigned has made numerous attempts to contact Mr. Pereira by mail and by telephone. All attempts have been unsuccessful. However, the undersigned attorney was able to reach Mr. Pereira's girlfriend "Linda". Linda indicated that Mr. Pereira was not willing to sign any documents supporting the instant application.

Mr. Pereira's last known address is: 1581 18<sup>th</sup> Avenue, Kingsburg, California 93631.

The present Petition is believed to provide proof of the pertinent facts and the last known address of the non-signing inventor in accordance with M.P.E.P. § 409.03 and 37 C.F.R. § 1.47. The fee set forth in 37 C.F.R. § 1.17(i) of \$130.00 is also submitted herewith.

I hereby declare that all statements made herein are of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed on this 13<sup>th</sup> day of August, 2001, at Newport Beach, California.

  
David G. Duckworth

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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,850	06/19/2000	Edward A. Marue	546-P-8-USA	4479

7590

12/14/2001

Drummond & Duckworth  
Suite 500  
4590 MacArthur Boulevard  
Newport Beach, CA 92660

EXAMINER

RAMIREZ, RAMON O

ART UNIT

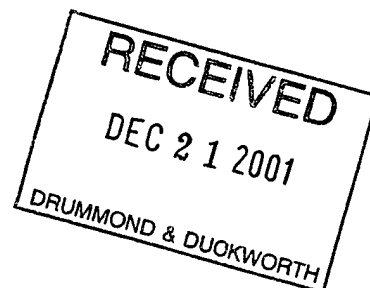
PAPER NUMBER

3632

DATE MAILED: 12/14/2001

*Response / Petition due*  
*January 14, 2002.*

Please find below and/or attached an Office communication concerning this application or proceeding.





*Detailed Action*

This is the third Office Action corresponding to communication filed on Aug 13, 2001.

*Response to Amendment*

The reply filed on Aug 13, 2001 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the supplemental declaration is not signed by all the listed inventors. Applicant legal counsel filed a petition under Rule 1.47 to correct this; however, it appears that the petition should be filed under Rule 1.183. This type of petition is handled by the Office of Petitions, not by the Examiner Sectors. Petitions under Rule 1.47 is for the filing of an application. In this particular case, the application was filed by all the inventors; it is the supplemental declaration that lacks the signature of one of the inventor.

Applicant is suggested to file a petition to under Rule 1.183. Specific questions about Petitions should be directed to the Office of Petitions (703-305-9282)

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Art Unit: 3632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner **Ramírez** at telephone number (703) 308-0748.

The examiner can be normally reached on Monday-Thursday and alternate Fridays.

The fax numbers for this Group are (703) 305-7687 (for formal papers), and (703) 308-3519 (for informal papers).

Any inquiry of general nature relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

R.O.RAMIREZ  
December 13, 2001

RAMON O. RAMIREZ  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600  
ART UNIT 3632